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8
9 UNITED STATES DISTRICT COURT
10 CENTRAL DISTRICT OF CALIFORNIA
11 SOUTHERN DIVISION

12 JAMES R. GLIDEWELL DENTAL
CERAMICS, INC. dba GLIDEWELL
13 LABORATORIES, a California
corporation,

14 Plaintiff,

15 vs.

16 KEATING DENTAL ARTS, INC., a
17 California corporation

18 Defendant.

19
20 AND RELATED
21 COUNTERCLAIMS.

Case No. SACV11-01309-DOC(ANx)

**GLIDEWELL LABORATORIES'
OPPOSITION TO DEFENDANT
KEATING DENTAL ARTS, INC.'S
MOTION FOR SUMMARY
JUDGMENT OF (1) NO
INFRINGEMENT OF
GLIDEWELL'S REGISTERED
TRADEMARK, (2) NO
VIOLATION OF SECTION 43(a)
OF THE LANHAM ACT, AND (3)
NO UNFAIR COMPETITION
UNDER CALIFORNIA LAW
Hearing**

Date: December 17, 2012

Time: 8:30 a.m.

Ctrm: 9D, Hon. David O. Carter

Pre-Trial Conf.: January 28, 2013

Jury Trial: February 26, 2013

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(PURSUANT TO PROTECTIVE ORDER DATED JANUARY 30, 2012)

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I. INTRODUCTION¹

Defendant Keating Dental Arts, Inc. (“Keating”) contends that it is entitled to summary judgment against Plaintiff James R. Glidewell Dental Ceramics, Inc. (“Glidewell”) principally on the ground that Glidewell’s BruxZir mark is weak. Keating’s argument fails with its premise: Glidewell’s BruxZir is both conceptually and commercially strong. The mark is conceptually strong because it is suggestive, and it is commercially strong in large part due to Glidewell’s substantial and sustained marketing campaign directed to promoting dental restoration product, principally crowns, bridges and zirconia milling blanks, under the mark. The commercial dominance of the BruxZir mark is undisputed: Glidewell has spent nearly REDACTED advertising goods under the mark and garnered sales of nearly REDACTED under the mark in the past 3 ½ years, and has amassed an impressive array of industry awards and recognition for its BruxZir-branded goods. Keating’s “evidence” to the contrary, principally comprised of dozens of unauthenticated hearsay-ridden web-pages printed out from third party websites that Keating believes reflect a “crowded field,” withers upon examination to just two arguable instances of uses of similar marks, a number far too low to overcome Glidewell’s evidence of commercial strength.

The remainder of Keating’s motion is anticlimactic. Keating admits that the goods are identical and the marketing channels overlap, thereby conceding two factors that reduce the required showing of similarity between the marks. Keating’s showing regarding the differences between the marks is perfunctory, and relies on its false premise that the BruxZir mark is generic or highly descriptive, which it is

¹ Glidewell relies herein on arguments and evidence submitted in support of its co-pending Motion for Partial Summary Judgment re: Infringement of a Federally Registered Mark (First Cause of Action) And Dismissal of Defendant’s Second Affirmative Defense and First Counterclaim (Dkt. #81-1) (“MSJ re Infringement”) and Glidewell’s Motion for Partial Summary Judgment as to Keating Dental Art, Inc.’s Invalidity Defense and Counterclaim (Dkt. #82-1) (“MSJ re Validity”), pursuant to *Fair Housing Council of Riverside County, Inc. v. Riverside Two*, 249 F.3d 1132, 1136-37 (9th Cir. 2001).

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not.

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Keating's irrelevant assertion that dentists exercise care in treating their patients, and its failure to explain why it adopted its mark in the face of obvious knowledge of Glidewell's senior BruxZir mark, leave the field clear for Glidewell to proffer actual evidence concerning the degree of consumer care and Keating's deceptive intent, which Glidewell does. On the whole, Keating fails even to generate a genuine issue of fact in its favor, much less to overcome any issue of material fact favoring Glidewell. The Court should deny Keating's motion.

II. ARGUMENT

A. Glidewell's BruxZir Mark is Valid

Keating contends that Glidewell's BruxZir mark is invalid. For the reasons set forth in Glidewell's co-pending MSJs re Validity and Infringement, as well as Glidewell's co-pending Opposition to Keating's Motion for Summary Judgment Cancelling Glidewell's Trademark Registration ("Opposition to Keating's Cancellation MSJ"), which are incorporated herein by reference, Keating's arguments fail to foreclose a genuine issue of fact in Glidewell's favor. Notably, Glidewell's BruxZir mark is registered (SGI 93), and is therefore presumed to be inherently distinctive – suggestive, at least – absent proof to the contrary by Keating. Keating fails to proffer proof, such as a consumer survey, sufficient to carry its burden of persuasion on this issue. Keating is therefore not entitled to summary judgment on this issue.

B. Likelihood of Confusion

1. Strength of the BruxZir Mark

a. The BruxZir Mark is Conceptually Strong

For the reasons set forth in Glidewell's co-pending MSJ re Validity, Glidewell's BruxZir mark is suggestive. Because Glidewell's BruxZir mark is registered, "mark is 'presumed to be distinctive and should be afforded the utmost protection.'" *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F. Supp. 457, 462 (N.D. Cal. 1991); *UGG Holdings, Inc. v. Severn*, 2005 U.S. Dist. LEXIS 45783 at *23 (C.D. Cal. Feb. 23, 2005). This is undoubtedly correct, as the BruxZir mark is at least suggestive and would therefore be inherently distinctive even if it lacked the benefit of federal registration. A mark is suggestive if "consumer response requires any sort of 'multistage reasoning process' to identify the characteristic of the product which the mark suggests." *Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 506 (9th Cir. 2011). The BruxZir mark is suggestive because a dentist must engage in multiple cognitive steps to progress from the mark itself to the characteristics of the product that it suggests: that crowns marketed under the brand are strong because they are appropriate for patients who "brux," i.e., who grind their teeth, and also that the crowns are made from zirconia, a particularly hard material. (SGI 97). Accordingly, Glidewell's BruxZir mark is suggestive. *Lahoti*, 636 F.3d at 508-09 (finding VERICHECK mark suggestive for check verification services); *Conversive, Inc. v. Conversagent, Inc.*, 433 F. Supp. 2d 1079, 1090 (C.D. Cal. 2006) (holding the marks CONVERSIVE and CONVERSIVE AGENT suggestive for software that simulates an online dialogue); *Sabinsa Corp. v. Creative Compounds, LLC*, 609 F.3d 175, 186 (3rd. Cir. 2010) (holding the FORSLEAN mark suggestive for weight loss products containing coleus forskohlii); *Citibank, N.A. v. Citibanc Grp., Inc.*, 724 F.2d 1540, 1545 (11th Cir. 1984) (holding CITIBANK suggestive because it at best "suggests a modern or urban bank"). (SGI 144) Because the mark is inherently distinctive, this factor weighs in favor of finding that confusion is likely. *Lahoti*, 636 F.3d at 508-09.

b. The BruxZir Mark is Commercially Strong

(i) **Keating Fails to Demonstrate Absence of a Genuine Issue of Fact regarding Commercial Strength**

Keating attacks the commercial strength of Glidewell's BruxZir mark, contending that the mark is weak because "many" companies have used "Brux" and "Z" or "Zir" to refer to products for use by bruxers and products associated with zirconia, respectively. Keating, however, lacks evidence of such widespread use, which does not in fact exist. In any event, Glidewell does not contend that *any* use of "Brux" or "Zir" infringes Glidewell's BruxZir mark; rather, Glidewell contends that Keating's use of a *particular* brand – KDZ Bruxer – infringes that mark.

As an initial matter, none of Keating's evidence of these "crowding" uses is admissible. Keating's "crowding" facts are set forth at paragraphs 50-51 of its SUF. Keating's evidence of these crowding uses consists entirely of a series of third party webpages printed out and submitted as Keating's Exhibits 24, 27-29, 31, 34, 37, 39, 42, 43, 93, 94, 96, 99-103, 105-106, 108-114, 119-137. However, none of these websites are authenticated, and all of them constitute inadmissible hearsay. Fed. R. Evid. 802, 901; *Orr v. Bank of Am.*, 285 F.3d 764, 773-79 (9th Cir. 2002). Keating could have overcome these deficiencies by taking discovery from some or all of these third parties prior to the close of discovery, but chose not to do so. It cannot now be permitted to remedy its oversight by skirting the rules of evidence.

In any event, even if Keating's evidence were admissible, it would not suffice to justify summary judgment, for several reasons. First, Keating offers no evidence regarding how these marks are promoted in the marketplace or that any of these marks have any commercial strength or impact at all; no evidence that any goods offered under these marks are promoted through any channels other than the Internet; and no evidence regarding how long any products have been promoted under any of these marks. In attempting to demonstrate that a mark has been weakened by substantial third party use, it is not enough for the defendant to merely

1 present the allegedly crowding uses; he must present evidence that the uses have
2 impaired the strength of the plaintiff's mark. *Lahoti*, 636 F.3d at 508-9 (evidence
3 of three uses in the same field insufficient to demonstrate a crowded field where,
4 e.g., there was no evidence that any of these users had used the identical mark to
5 compete with the plaintiff or had impaired the strength of plaintiff's mark); *Scarves*
6 *By Vera, Inc. v. Todo Imports Ltd.*, 544 F.2d 1167, 1173-74 (2d Cir. 1976)
7 (rejecting argument that third-party registrations impaired the strength of plaintiff's
8 mark because "[t]he significance of third-party trademarks depends wholly upon
9 their usage. Defendant introduced no evidence that these trademarks were actually
10 used by third parties, that they were well promoted or that they were recognized by
11 consumers."); *Electropix v. Liberty Livewire Corp.*, 178 F. Supp. 2d 1125, 1130
12 (C.D. Cal. 2001) (evidence of over 200 uses of the LIVEWIRE mark insufficient to
13 undermine strength of mark, where many of the companies did not use the identical
14 mark and only two used the mark in the same or a similar industry). This, Keating
15 has failed to do. Thus, Keating's assertion that the market is crowded is
16 unsupported by evidence sufficient to even create a genuine issue of fact, much less
17 to foreclose one.

18 Second, Keating fails to proffer evidence of a sufficient number of
19 "crowding" uses to undermine the strength of the BruxZir mark. Keating's "many"
20 examples of companies that offer "dental products for use with bruxers" or
21 "associated with zirconia" turn out to comprise 40 companies and dentists offering
22 43 products under names that fit the criteria that Keating apparently believes are
23 relevant. (Deft's SUF 50-51) In order for this evidence of "other uses" to bear on
24 the issue at hand, the "crowding" marks would have to be confusingly similar to
25 Glidewell's BruxZir mark. *Electropix*, 178 F. Supp. 2d at 1130. However, of these
26 44 uses, none of the 16 identified in Keating's SUF 50 includes any combination of
27 "Brux" and either "Zir" or "Z," and of those 16 only one ("BruxArt") involves a
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1 product that competes with those covered by Glidewell's BruxZir registration.
2 (Deft's SUF 50, Exs. 114, 121-135) These 16 uses are therefore irrelevant to the
3 strength of the BruxZir mark. Moreover, of the remaining 28 purported uses
4 reflected in Keating's SUF 51:

5 • Eleven – exemplified by “Zir-Max” – contain only a “Zir” or “Z”
6 fragment without any “Brux” component, or a “Brux” element with a distinguishing
7 suffix (“BruxThetix”), and are therefore phonetically dissimilar.

8 • Six – “Z-Brux” (Assured Dental Lab), “Brux” (Authentic Dental),
9 “Bruxer All Zirconia” (China Dental Outsourcing), “Full Solid Bruxer Zirconia”
10 (Fusion Dental Lab), “Bruxer Crown” (Pittman Dental), “Full Contour Zir” (Somer
11 Dental Labs) – were discontinued after the dental labs that used those names
12 received cease and desist letters from Glidewell's General Counsel. (SGI _ [Supp.
13 Allred Decl., also cite to Keating's Ex#]) This fact tends to support, not undermine,
14 Glidewell's showing that BruxZir is a strong mark. *Morningside Grp., Ltd. v.*
15 *Morningside Capital Grp., L.L.C.*, 182 F.3d 133, 139 (2d Cir. 1999) (holding that
16 evidence of third party use of similar marks that are later discontinued do “not
17 weaken the mark—instead it strengthens it, because the successful policing of a
18 mark adds to its strength to the extent that it prevents weakening of the mark's
19 distinctiveness in the relevant market”). In addition, Pittman Dental's reference to
20 a “Bruxer Crown” appeared in a Twitter post advertising a different product (a
21 “custom Bruxer bur block”) and was not an effort to market, promote or advertise
22 any sort of crown; it is therefore irrelevant.

23 • Three – “Full Zirconia for Bruxing Patients” (Continental Dental),
24 “All Zirconia Bruxer” (Trachsel Dental) and “Bruxer” (York Dental Lab) – have
25 been discontinued, and in any event all of these labs are or shortly will be
26 Glidewell-authorized laboratories. (SGI 51) These uses therefore do not constitute
27 “crowding” uses; to the contrary, they indicate commercial strength. *Id.*; *Mrs. U.S.*
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1 *Nat'l Pageant, Inc. v. Miss U.S.A. Org., LLC*, 2012 U.S. Dist. LEXIS 97147, at *
2 31-38 (W.D.N.Y. 2012).

3 • Several (e.g., “All Zirconia for Bruxers”) appear not to reflect a
4 trademark usage at all but rather a description of or reference to a full contour
5 zirconia crown.

6 Thus, none of these purported uses are probative of whether the commercial
7 strength of the BruxZir mark has been impaired; certainly, Keating has offered no
8 evidence (such as evidence of advertising expenditures promoting goods under
9 those marks) that would support a finding to that effect. *Electropix*, 178 F. Supp.
10 2d at 1130; *Mrs. U.S. Nat'l Pageant*, 2012 U.S. Dist. LEXIS 97147, at * 31-38.

11 After the chaff is cleared away, Keating is left with only six examples of
12 marks that might arguably have supported its argument, had Keating proffered
13 sufficient evidence of the commercial impact of these marks: “Z-Brux” (Barth
14 Dental Labs), “Bruxer Crown” (Cosmetic Dentistry of SA), “Full Zirconia
15 (Bruxer)” (Dani Dental), “GPS BruxArt” (GPS Dental Lab), “Bruxer Crowns”
16 (Infinity Dental Lab), and “Xtreme Bruxer” (Mascola Esthetics). Of these:

17 • Cosmetic Dentistry of SA appears to be a dental office rather than a
18 dental laboratory, and advertises to patients rather than to dentists. (SGI 51, Ex.
19 119) This “use” is therefore not in the relevant market. Moreover, it appears from
20 context that Cosmetic Dentistry is using the term “‘Bruxer’ crown” in a descriptive
21 sense rather than in a trademark sense, i.e., to denote a source of goods.

22 • Infinity Dental Lab also appears to be using the term “‘Bruxer’
23 crowns” in a descriptive rather than a trademark sense. This is consistent with the
24 fact that “Bruxer” is in quotes; the right quote mark in Keating’s Ex. 108 appears to
25 have been unintentionally deleted.

26 • Keating’s evidence concerning Dani Dental’s use of the term “Full
27 Zirconia (Bruxer)” consists of a preprinted prescription form that includes a box
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next to the term “Full Zirconia (Bruxer).” This prescription form is deficient for at least two reasons: (i) it says little concerning whether or how this company markets any of its goods to dentists, and (ii) it appears that this entry is used descriptively to refer to a full zirconia crown that could be used for a patient with bruxism rather than in a trademark sense. Consistent with this, it does not appear that Dani Dental in fact advertises any product under the brand “Full Zirconia (Bruxer)” or any similar mark. (SGI 51, Ex. 43)

- Keating’s evidence concerning Mascola’s use of the term “Xtreme Bruxer” is similarly deficient: it consists of a preprinted prescription form that says little concerning whether or how Mascola markets any goods to dentists.

So, in the end, Keating is left with two marks that appear to be trademark uses directed to the relevant market: “Z-Brux” by Barth Dental Labs, and “GPS BruxArt” by GPS Dental Lab. Glidewell sent Barth Dental Labs a cease and desist letter concerning the “Z-Brux” brand on September 26, 2012, and expects this use to be discontinued shortly. (SGI 51, Ex. 34) In any event, two uses in the relevant market, unsupported by any evidence of advertising, sales or actual impairment of the commercial strength of the BruxZir mark, falls far short of the showing required to justify summary judgment (or even overcome Glidewell’s motion for partial summary judgment) on the basis of a “crowded market.” *E.g., Lahoti*, 636 F.3d at 508-09 (three “crowding” uses insufficient to overcome commercial strength) (Supp. Goldstein Decl. ¶ 24).

Keating also apparently thinks it significant that approximately 180 Glidewell-authorized dental laboratories offer crowns made with BruxZir zirconia milling blocks purchased from Glidewell under the BruxZir mark without identifying Glidewell. There is, however, no requirement that the authorized labs identify an affiliation to Glidewell, *Pneutek, Inc. v. Scherr*, 211 U.S.P.Q. 824 (T.T.A.B. 1981), and Keating offers no authority to the contrary. Here, too, the

evidence that Keating believes undermines the BruxZir mark actually demonstrates its strength. *Univ. of Georgia Athletic Ass'n v. Laite*, 756 F.2d 1535, 1545 (11th Cir. 1985); *Auburn Univ. v. Moody*, 2008 U.S. Dist. LEXIS 89578, at *20-21 (M.D. Ala. 2008). Accordingly, Keating fails to show that the BruxZir mark is weak.

(ii) **The Evidence Shows that the BruxZir Mark is Commercially Strong**

There is copious evidence of the commercial strength of Glidewell's BruxZir mark. A mark is commercially strong when it is widely recognized by relevant consumers in a particular market. *Lahoti* 636 F.3d at 508. Thus, a registrant's efforts to promote the mark in association with its goods or services can augment the strength of its mark as a source identifier. *Id.*; *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988) ("Marks may be strengthened by extensive advertising, length of time in business, public recognition, and uniqueness."). It is undisputed that the relevant consumers for Glidewell's BruxZir-brand crowns and bridges are dentists. (SGI 1, 99). Thus, Glidewell's efforts to promote – and success in promoting – the BruxZir mark to dentists is highly relevant to the strength of the mark. *Lahoti*, 636 F.3d at 508; *Century 21*, 846 F.2d at 1179.

Glidewell promotes its dental crowns and bridges under the BruxZir mark through a broad range of channels, including the Internet (through Glidewell's blog as well as www.BruxZir.com), direct mailers, trade shows, ads in dental industry publications, press releases, continuing education brochures, videos and training sessions for dentists, samples, and specialized prescription forms. (SGI 100). Over the period June 2009 to June 2012, Glidewell spent approximately REDACTED in promoting its products under the BruxZir mark through these channels. (SGI 101). About REDACTED of this was spent marketing Glidewell's BruxZir finished crowns and bridges, and about REDACTED was spent marketing Glidewell's BruxZir

1 zirconia milling blanks. (SGI 102). About REDACTED was spent on direct mail
 2 advertising, which was sent to roughly every dentist in the country, and another
 3 roughly REDACTED was spent on advertising in dental industry publications, with the
 4 remainder being allocated among Glidewell's other marketing channels. (SGI 103).

5 Notably, Glidewell's promotion of its BruxZir mark is overwhelming for its
 6 industry, in which no other dental laboratories spend more than about \$150,000 per
 7 year in marketing and advertising. (SGI 101) This is confirmed by Keating's own
 8 admission that Glidewell is:

9 REDACTED

10
 11 (SGI_ [SK Tr. 91:7-25])

12 Keating's perception of Glidewell's marketing prowess is correct:
 13 Glidewell's advertising of products under the BruxZir mark has accomplished
 14 substantial market penetration. (SGI 104). For example, between October 2009
 15 and November 2012, the www.BruxZir.com website received over twice as many
 16 unique pageviews as there are dentists in the United States. (SGI 105-106).
 17 Glidewell's direct mail advertising of products under the BruxZir mark is sent
 18 every quarter to nearly the entire population of dentists in the country. (SGI 107).
 19 Glidewell's promotion of the BruxZir product line in dental industry publications is
 20 consistent, ongoing and pervasive. (SGI 108). In addition, Glidewell attends
 21 dozens of trade shows and conventions a year around the country, especially the
 22 American Dental Association conventions. (SGI 111). At these conventions and
 23 trade shows, Glidewell consistently, prominently displays the BruxZir product line
 24 in a variety of contexts, including on the booth, the signage, in brochures, and
 25 takeaways. (SGI 112). In addition, Dr. Michael DiTolla, Glidewell's Director of
 26 Clinical Education and Research, and Robin Carden, Glidewell's Vice President of
 27 Research and Development, make educational videos, write articles and give
 28

1 presentations concerning Glidewell's BruxZir-branded products. (SGI 113-114).

2 Glidewell's BruxZir-branded products have received wide recognition in the
3 dental industry. (SGI 115). Numerous articles have been written by third parties
4 concerning the BruxZir products and referencing them by Glidewell's registered
5 mark. (SGI 116). In addition, Glidewell has received numerous awards
6 recognizing the superiority of its BruxZir-brand dental crowns and bridges. (SGI
7 117).

8 The commercial strength of the mark is also demonstrated by the volume of
9 goods sold under the mark. *Lahoti*, 636 F.3d at 509. Again, Keating admits the
10 truth: when comparing Keating's sales to Glidewell's, Shaun Keating observed that
11 "[Glidewell doesn't] set the bar. They are the bar." (Deposition of Shaun Keating,
12 Tr. 92:1-13) BruxZir is the number one prescribed brand of full zirconia dental
13 crown in the country. (SGI 118). From June 2009 to September 2012, Glidewell
14 has sold approximately REDACTED dental crowns and bridges under the mark. (SGI
15 119). In monetary terms, from July 2009 to September 2012 Glidewell sold nearly
16 REDACTED worth of dental crowns and bridges under the BruxZir mark. (SGI
17 120).

18 In addition, the very strong brand recognition that Glidewell has achieved
19 through its extensive advertising of its dental crowns and bridges under the BruxZir
20 mark is evidenced by third party recognition of the strength of the brand. *Nautilus*
21 *Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1343 (Fed. Cir. 2004). A
22 large portion of dentists in the U.S. recognize the BruxZir brand for dental crowns
23 and bridges, as shown by, among other things, third party research. (SGI 121-123).
24 Moreover, the fact that many companies have abandoned confusingly similar marks
25 when confronted with the BruxZir mark (SGI 51), further indicates the industry's
26 recognition of the strength of the mark. *Morningside Grp.*, 182 F.3d at 139.

27 The commercial strength of the mark is further demonstrated by the fact that
28

1 it is relatively unique in its field. *Century 21*, 846 F.2d at 1179. As shown above,
 2 Keating has come forward with only two actual examples of arguably similar marks
 3 used in connection with crowns, neither of which is supported by any proof that
 4 either of those marks have any market strength of their own. So, even were
 5 Keating's evidence on this point admissible, it would fail to prove a crowded field
 6 for the reasons set forth above. (SGI 50-51).

7 In factual settings similar to that here, the Ninth Circuit and its subordinate
 8 district courts have not hesitated to affirm entry of summary judgment in favor of
 9 the registered mark. *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179
 10 (9th Cir. 1988) (holding that evidence that Century 21 had "expended several
 11 million dollars" in advertising real estate services under the mark and that the mark
 12 had been used in connection with real estate sales in excess of one billion dollars
 13 supported the district court's determination that the mark was strong); *Lahoti*, 636
 14 F.3d at 509 ("the district court found that Vericheck had a longstanding use of the
 15 mark, promoted it through trade shows and promotional incentives, expanded its
 16 territory and client list and increased its sales. The district court's conclusion that
 17 the mark is strong is valid."); *UGG Holdings*, 2005 U.S. Dist. LEXIS 45783 at *23
 18 (holding the UGG mark to be "extremely strong" where the plaintiff has spent more
 19 than \$8 million advertising the brand and received extensive media coverage).

20 Here, Glidewell's REDACTED in advertising, the extensive exposure in the dental
 21 industry generated by Glidewell's advertising, trade show attendance and numerous
 22 industry awards, as well as Keating's admission that Glidewell is REDACTED
 23 REDACTED similarly demonstrate the strength of
 24 the BruxZir mark. Accordingly, the mark is commercially strong. (SGI 126)

25 **(iii) Keating's Authority is Easily Distinguishable**

26 Keating's authority on this point is easily distinguished. In *Instant Media*,
 27 *Inc. v. Microsoft Corp.*, 2007 U.S. Dist. LEXIS 61443, at *35-36 (N.D. Cal. 2007),
 28

1 the court held that the mark "I'M" was weak when used with internet software
 2 because the field of trademarks using variations of "IM" was crowded due to the
 3 over 600 registered marks containing a form of IM, I'M, or I AM, including
 4 approximately 185 in the same International Classes for which the plaintiff
 5 registered its mark. This case says nothing regarding the strength of the BruxZir
 6 mark, as to which Keating points to only a handful of even arguably pertinent uses.

7 In *Network Automation, Inc. v. Hewlett-Packard Co.*, 2009 U.S. Dist. LEXIS
 8 125835, at *16, *24 (C.D. Cal. 2009), the court determined that the "Network
 9 Automation" mark was weak because the plaintiff admitted that it purely described
 10 the product, and that it was widely used in a generic sense. *Id.* at *16. In contrast,
 11 here the BruxZir mark does not describe Glidewell's full contour zirconia crown,
 12 and Keating fails to meet its heavy burden on summary judgment of proving that
 13 the mark is generic (in fact, the uncontroverted evidence proves the converse).

14 In *Glow Industries, Inc. v. Lopez*, 252 F. Supp. 2d 962 (C.D. Cal. 2002), the
 15 senior mark was commercially weak both because it had "a relatively limited sales
 16 presence in a handful of states and on the Internet," it "had developed the market
 17 for its product using relatively low budget marketing techniques," and it competed
 18 in "an exceedingly crowded field" of beauty products using registered marks that
 19 were phonetically identical as well as an unspecified additional quantum of
 20 trademark applications and unregistered trade usages. *Id.* at 973, 990. Here, the
 21 facts are directly opposite: Glidewell has overwhelming evidence of commercial
 22 strength, and Keating proffers no such evidence for its KDZ Bruxer mark.

23 Finally, in *One Indus., LLC v. Jim O'Neal Distib., Inc.*, 578 F.3d 1154, 1164-
 24 1165 (9th Cir. 2009), the Court held that the strength of mark factor weighed in
 25 favor of finding a likelihood of confusion even though there were four other
 26 companies in the motocross industry, including plaintiff, that were "crowding" the
 27 market with similar "O" symbols on their motocross apparel and equipment.
 28

2. Proximity of Glidewell's and Keating's Goods

"Directly competing goods are in the closest proximity under the likelihood of confusion analysis." *Conversive*, 433 F. Supp.2d at 1091. If goods directly compete, "confusion will usually arise" *Id.* Keating admits that its dental crowns and bridges directly compete with Glidewell's dental crowns and bridges. (Dkt# 86, p. 16:5-7) Thus, this factor indicates that confusion is likely. *Lahoti*, 636 F.3d at 508; *Century 21*, 846 F.2d at 1179; *Conversive*, 433 F. Supp.2d at 1091.

3. Similarity of the Marks

To evaluate the similarity of the marks, courts look to the "sight, sound and meaning" of the marks, and recognize that "any similarities weigh more heavily than differences." *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1211 (9th Cir. 2012). When evaluating the similarities between marks, a lesser degree of similarity is required when the goods are directly competitive. *AMF, Inc. vs. Sleekcraft Boats*, 599 F.2d 343, 350 (9th Cir. 1979); *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1392 (9th Cir.1993). In addition, when a mark is strong, a lesser degree of similarity will suffice to establish likely confusion. *E.g., Perfumebay.com Inc. v. Ebay, Inc.*, 506 F.3d 1165, 1174 (9th Cir. 2007).

Keating makes several arguments in an effort to distinguish the parties' marks, none of which bear scrutiny. First, the context in which the two marks are presented in the market is important. As shown above, the products sold under the marks directly compete, and Glidewell's BruxZir mark is an extremely strong mark based on, e.g., Glidewell's massive advertising effort and the commercial acclaim garnered by BruxZir crowns. Accordingly, less similarity is required in order to find that confusion is likely. *Official Airline Guides*, 6 F.3d at 1392; *Nautilus Grp.*, 372 F.3d at 1335.

In any event, the marks at issue here are quite similar. Keating makes much of the particular font used in advertisements displaying Glidewell's BruxZir mark.

1 However, it fails to proffer any evidence that the partial difference in fonts or that a
 2 sliver of the “Z” overlaps the “x” is actually likely to impact the consciousness of
 3 the relevant consumers. Similarly, while Keating includes a background oval
 4 surrounding its mark, this generic design feature fails to differentiate Keating’s
 5 brand from Glidewell’s mark. (SGI 43) *Wella Corp. v. Cal. Concept Corp.*, 558
 6 F.2d 1019, 1022-23 (C.C.P.A. 1977). Keating has merely prefaced a root word
 7 (“Bruxer”) that is nearly identical to the entirety of Glidewell’s mark (“BruxZir”)
 8 with a three-letter acronym (“KDZ”) that does not on its face serve any source-
 9 identifying function. (SGI 139). Keating capitalizes the first letter of the “Bruxer”
 10 component of its mark, just as Glidewell capitalizes the first letter of “BruxZir.”
 11 (SGI 138). While Keating has apparently attempted to highlight the “KDZ” portion
 12 of its mark in some of its advertising, the fact that KDZ is an opaque acronym
 13 means that it cannot merely rely on the prefix to differentiate; in any event, in the
 14 text of its advertisements the term is no more prominent than the “Bruxer” root of
 15 its mark. (SGI 140). Indeed, if Keating’s addition of “KDZ” to the root “Bruxer”
 16 is likely to accomplish anything in this context, it is to suggest to dentists some
 17 association or affiliation between Keating and Glidewell. *UMG Recordings, Inc. v.*
 18 *Mattel, Inc.*, 100 U.S.P.Q.2d 1868, 2011 WL 5014005 (T.T.A.B. 2011).

19 The likelihood that the similarities of the marks will confuse is heightened by
 20 the fact that buyers in the relevant market (i.e., dentists) are not likely to consider
 21 the marks side by side as a shopper would two competing brands in a supermarket;
 22 instead, they are likely to consider the marks separately at different points in time.
 23 (SGI 141). This fact tends to support the determination that confusion is likely,
 24 (SGI 142), because subtle differences in the marks are less likely to be “in the
 25 buyer’s mind” when the buyer makes the decision to purchase Keating’s dental
 26 crowns under the KDZ Bruxer mark. *Fleischmann Distilling Corp. v. Maier*
 27 *Brewing Co.*, 314 F.2d 149, 161 (9th Cir. 1963) (“In determining whether there is a
 28

1 likelihood of confusion we must remember that the members of the purchasing
2 public have only general impressions which must guide them in the selection of
3 products.”); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 433 (5th Cir. 1984)
4 (“The inability [of consumers] to compare the products side by side and observe the
5 precise differences in appearance may increase the likelihood of confusion.”).

6 In addition, the meaning associated with a mark may also indicate a
7 likelihood of confusion. “Confusing similarity may exist if the two terms convey
8 the same idea or meaning.” *Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc.*, 870 F.2d
9 512, 518 (9th Cir. 1989). Here, the BruxZir mark and the KDZ Bruxer mark
10 suggest similar meanings. BruxZir suggests a product indicated for people who
11 suffer from bruxism, i.e., people who tend to grind their teeth (“Brux”) and that the
12 product is made of zirconia (“Zir”). (SGI 144). Similarly, KDZ Bruxer suggests a
13 product indicated for people who suffer from bruxism (“Bruxer”) and that the
14 product is made of zirconia (the “Z” in KDZ). (SGI 143, 145).

15 Cases are legion in which identity or substantial similarity in marks that share
16 only a suffix has been found sufficient to demonstrate a likelihood of confusion,
17 particularly where the goods branded under the marks are competitive. *Earthquake*
18 *Sound Corp. v. Bumper Indus.*, 352 F.3d 1210, 1217-18 (9th Cir. 2003) (finding
19 that EARTHQUAKE and CARQUAKE were confusingly similar when both used
20 for auto audio equipment); *Apple Computer, Inc. v. Formula International, Inc.*,
21 725 F.2d 521, 526 (9th Cir. 1984) (holding that “the addition of the prefix ‘Pine’ to
22 the trademark ‘Apple’ presented a likelihood of confusion,” particularly since the
23 mark might “suggest that the computer kits are manufactured by licensees or
24 subsidiaries of Apple.”); *KOS Pharmaceuticals, Inc. v. Andrix Corp.*, 369 F.3d 700
25 (3d Cir. 2004) (finding that the marks ADVICOR and ALTOCOR are confusingly
26 similar when both used for prescription cholesterol reducing drugs); *Conversive*,
27 433 F.Supp.2d at 1091 (finding CONVERSAGENT to be “phonetically and
28

1 visually very similar” to CONVERSIVE AGENT).

2 Keating cites a raft of cases in which courts have found confusion unlikely
3 when it is based on generic or highly descriptive common elements of two
4 composite marks. These cases are inapposite, for the primary reason that “Brux” is
5 neither generic nor highly descriptive in the market for full contour zirconia
6 crowns.

7 **4. Evidence of Actual Confusion**

8 “Evidence of actual confusion constitutes persuasive proof that future
9 confusion is likely.” *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 902
10 (9th Cir.2002). The evidence of actual confusion in this case is pervasive. RE
11 DA
12 CT
13 ED

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Moreover, for all of these examples of apparent confusion, including those
by the twelve dentists who are cooperating with Keating, proof that the dentists

1 knew they were ordering KDZ Bruxer crowns rather than BruxZir crowns would
 2 not end the matter. Given the dominance of the BruxZir mark in the market for
 3 dental restoration products, and the fact that the marks are not compared side by
 4 side, it is likely that Keating has benefited from “initial interest confusion,” where
 5 the infringing mark captures initial attention from consumers who then realize that
 6 the product is different from that sold under the dominant brand but go ahead and
 7 purchase the product anyway. *Brookfield Commc’ns, Inv. v. W. Coast Entm’t*
 8 *Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999); *Conversive, Inc.*, 433 F. Supp. 2d at
 9 1093. (Supp. Goldstein Decl. ¶ 25). In effect, the similarity of the junior mark to
 10 the senior mark garners it unearned credibility, which then translates into actual
 11 sales. Keating’s dentist declarations do not even address the possibility of initial
 12 interest confusion; they therefore fail to foreclose a finding of confusion even as to
 13 those twelve dentists.

14 Where there are even a handful of instances of actual confusion, the courts
 15 have not hesitated to grant summary judgment in favor of the senior mark. For
 16 example, in *Century 21*, a single instance of actual confusion by a consumer in the
 17 relevant market was sufficient to support summary judgment for the plaintiff.
 18 *Century 21*, 846 F.2d at 1179. Similarly, in *UGG Holdings*, the court found there
 19 to be “abundant evidence of actual consumer confusion” where there was evidence
 20 of 19 instances of confusion. *UGG Holdings*, 2005 U.S. Dist. LEXIS 45783 at
 21 *25-26. Here, there is a mountain of evidence of actual, direct confusion, including
 22 one dentist characterizing Keating’s branding as “sneaky” and several instances of
 23 Keating employees feeling it necessary to “explain” the differences between KDZ
 24 Bruxer crowns and BruxZir crowns and reminding dentists that BruxZir is a
 25 proprietary name or the “tradename” of another company. (SGI 149, 159) This
 26 evidence of actual confusion precludes summary judgment for Keating.

27 5. Marketing Channels

1 “Convergent marketing channels increase the likelihood of confusion.”
 2 *Sleekcraft*, 599 F.2d at 353. Here, Keating admits that the marketing channels used
 3 by Glidewell and Keating to promote their goods under their respective BruxZir
 4 and KDZ Bruxer marks overlap. (Dkt# 86, p. 20:20-23) Indeed, they are nearly
 5 identical. (SGI 100, 164-166). This strongly supports a finding that confusion is
 6 likely. *Century 21*, 846 F.2d at 1179.

7 **6. Type of Goods and Degree of Care**

8 Keating contends that dentists are unlikely to be confused because they are
 9 highly educated and specially trained professionals. However, even sophisticated
 10 consumers, such as dentists, are not immune from mistaking one mark for another.
 11 *Schering Corp. v. Alza Corp.*, 207 U.S.P.Q. 504 (T.T.A.B. 1980) (finding that while
 12 physicians and pharmacists are knowledgeable in their fields, they are not
 13 necessarily knowledgeable as to marks, thus not immune from mistaking one mark
 14 for another); *Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301 (T.T.A.B. 2004)
 15 (“[T]here is no reason to believe that medical expertise as to pharmaceuticals will
 16 ensure that there will be no likelihood of confusion as to source or affiliation.”);
 17 *KOS Pharmaceuticals, Inc. v. Andrx Corp.*, 369 F.3d 700, 716 n.13, 717 (3d Cir.
 18 2004).

19 The issue is not whether dentists put great care into the treatment of their
 20 patients, but rather the degree of care that dentists apply to selecting one full
 21 contour zirconia crown over another. Keating submits no evidence that might
 22 answer that question. But Glidewell does: a dentist’s selection of one full contour
 23 zirconia crown over another is not a decision that inherently requires a high degree
 24 of care. (SGI 166) While there are aesthetic differences between different brands
 25 of full contour zirconia crown, the properties of these crowns are highly similar
 26 because all of these crowns are made of the same material – zirconia. (SGI 166).
 27 The price differential between Glidewell’s BruxZir-brand crowns and Keating’s
 28

1 KDZ Bruxer crowns (\$99 v. \$139) is not so great as to reward focused attention on
2 the brand under which the crowns are marketed. (SGI 166) So, this factor too
3 suggests that confusion is likely.

4 Moreover, even if there were evidence that a high degree of care were used
5 by dentists in selecting a particular brand of monolithic zirconia crown, that would
6 not be the end of the matter. Where there is evidence that sophisticated consumers
7 are actually confused (as there is here), the likelihood of confusion based on the
8 degree of care factor is enhanced. *Conversive*, 433 F.Supp.2d at 1093. Moreover,
9 even where a high degree of care is exercised, initial interest confusion may still
10 exist. *Id.* That is exactly the situation here. In any event, even if this factor
11 supported Keating (which it does not), it would not be sufficient to overcome
12 Glidewell's strong showing that confusion is likely. *Pacific Telesis Group v.*
13 *International Telesis Communications*, 994 F.2d 1364, 1369 (9th Cir. 1993).

14 7. Keating's Intent in Selecting the Mark

15 Although proof of intent to deceive consumers is not necessary to establish
16 trademark infringement, intent is relevant because, "[w]here an alleged infringer
17 chooses a mark he knows to be similar to another, one can infer an intent to
18 confuse." *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1293 (9th
19 Cir.1992) (*citing Sleekcraft*, 599 F.2d at 354). This rule also applies where the
20 junior user continues to use a mark that it previously selected after having been
21 informed of the senior mark. *UGG Holdings*, 2005 U.S. Dist. LEXIS 45783 at *27.

22 The evidence indicates that Keating was aware of Glidewell's BruxZir mark
23 when it made the decision to begin selling competing products under the KDZ
24 Bruxer mark. It is undisputed that Keating selected its KDZ Bruxer mark in the
25 winter or spring of 2011. (SGI 168). By that time, Glidewell's BruxZir mark was
26 already well known in the industry; indeed, Glidewell had already spent about
27 REDACTED promoting its goods under the BruxZir mark. (SGI 170). In
28

1 connection with its brand selection process, Keating, among other things, (1)
 2 commissioned a trademark search report, (2) performed an “extensive review of
 3 dental journal advertisements by other dental labs,” (3) conducted an “informal
 4 trademark search for ‘KDZ’ and ‘bruxer,’” and (4) an “informal survey current
 5 Keating clients in March/April 2011” (SGI 171). At least Robert Brandon,
 6 Keating’s General Manager of the Laboratory, reviewed the search report during
 7 the brand selection process. (SGI 172). Given that the BruxZir mark was
 8 registered on the Principal Register in January 2010, the trademark search report
 9 undoubtedly contained a reference to Glidewell’s BruxZir mark. Moreover, given
 10 the extensive advertising that Glidewell had already conducted under its BruxZir
 11 mark, from 2009 through early 2011, there is overwhelming evidence that Keating
 12 was either already aware of Glidewell’s BruxZir mark, or became aware of it
 13 through the brand selection process, prior to selecting its KDZ Bruxer brand.

14 Moreover, it is undisputed that Keating was informed of the Glidewell
 15 BruxZir mark by no later than August 9, 2011, and despite its knowledge of
 16 Glidewell’s senior mark continued to promote its competing crowns and bridges
 17 under the KDZ Bruxer brand. (SGI 37)

18 Nevertheless, Keating contends that it acted with no bad intent. First,
 19 Keating states that it began using the “KDZ” prefix with different suffixes on
 20 different types of products in 2006. Glidewell assumes for the purpose of this
 21 motion that that is true; it is also irrelevant. Second, Keating states that it chose the
 22 “KDZ Bruxer” name as part of a family of new “KDZ” product names. Again,
 23 while this may be true, it fails to negative bad intent; could I really call my new soft
 24 drink “Phil’s Coca-Cola” if I just released two other “Phil’s” soft drinks at the same
 25 time? Third, Keating states that it appended “Bruxer” to “KDZ” because bruxers
 26 were the target patient for the new crown. However, the evidence to which Keating
 27 cites here fails to carry the point; this is not in fact what Shaun Keating says.
 28

1 Finally, Keating notes that it sought advice of counsel in connection with the
 2 selection of the KDZ Bruxer brand. However, Keating fails to reveal what that
 3 advice was; accordingly, it cannot hide behind its counsel's skirt. *Columbia*
 4 *Pictures Indus., Inc. v. Krypton Broadcasting of Birmingham, Inc.*, 259 F.3d 1186,
 5 1196 (9th Cir. 2001).

6 Evidence of intent to deceive the public is generally circumstantial.
 7 *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011).
 8 Here, substantial evidence of Keating's intent to free-ride on Glidewell's good will
 9 in the BruxZir mark exists, and Keating points to nothing to tip the scales back in
 10 its favor. This factor favors Glidewell.

11 **8. Likelihood of Expansion of the Product Lines**

12 As the parties already directly compete, this factor is unimportant.

13 **9. Conclusion: Confusion is Likely**

14 Thus, the *Sleekcraft* factors strongly support a finding that confusion is
 15 likely. The Court should deny Keating's request for summary judgment.

16 **C. Keating's Fair Use Defense is Frivolous**

17 Keating claims that it is entitled to use "Bruxer" even if its use causes
 18 consumer confusion because the use is protected by the "classic" fair use defense.
 19 There are three elements to the "classic" fair-use defense: (1) defendant's use of the
 20 term is not as a trademark or service mark; (2) defendant uses the term "fairly and
 21 in good faith;" and (3) defendant uses the term "only to describe" its goods or
 22 services. 15 U.S.C. § 1115(b)(4). Thus, the "classic fair use" defense applies
 23 where a party uses a descriptive term not as a trademark but instead to describe its
 24 own goods. *Sierra On-Line, Inc. v. Phoenix Software, Inc.*, 739 F.2d 1415, 1423
 25 (9th Cir. 1984); *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 908 (9th Cir.
 26 2003). Keating's use of the term "Bruxer" fails at least two of the above elements:
 27 it is used as a trademark, and it is not used "only to describe" Keating's goods.
 28

1 “To determine whether a term is being used as a mark [for purposes of the
2 fair-use defense], we look for indications that the term is being used to associate it
3 with a manufacturer.” *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand*
4 *Mgmt., Inc.*, 618 F.3d 1025, 1040 (9th Cir. 2010). Courts often have to look to
5 circumstantial evidence of whether a term is being used as a trademark. *Id.*
6 (“Indications of trademark use include whether the term is used as a symbol to
7 attract public attention, which can be demonstrated by the lettering, type style, size
8 and visual placement and prominence of the challenged words.”).

9 Here, Keating has admitted that uses the term “bruxer” as a trademark: it
10 applied to the Patent and Trademark Office to *register* the mark “KDZ BRUXER,”
11 admitted that it uses the mark as a trademark, and repeatedly referred to the KDZ
12 BRUXER mark as a “trademark” in its Second Amended Answer. (Dkt. #57-1
13 (“SAA”) ¶ 13 [“Defendant admits that it has used in commerce the term KDZ
14 BRUXER as a trademark in connection with advertising of, sale of, or offer to sell
15 dental prostheses.”], ¶ 41). This is fatal for Keating’s fair use defense. *Sierra On-*
16 *Line*, 739 F.2d at 1423; *Henry Heide, Inc. v. George Ziegler Co.*, 354 F.2d 574, 577
17 (7th Cir. 1965).

18 Keating tries to escape the consequences of its admissions by contending that
19 it disclaimed “Bruxer” in its trademark application for KDZ Bruxer. But that fact is
20 irrelevant because a disclaimer does not remove the disclaimed term from the mark.
21 *Sleeper Lounge Co. v. Bell Mfg. Co.*, 253 F.2d 720, 724 n.1 (9th Cir. 1958);
22 *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 979-80 (C.C.P.A. 1965) (same).
23 If a party could escape infringement simply by disclaiming descriptive words, this
24 would become a common tactic to enable infringement. The courts, however, have
25 rejected such tactics. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985).
26 Keating’s unilateral disclaimer of “Bruxer,” therefore, does not convert its
27 infringement into fair use.
28

Further, Keating is not using “Bruxer” only in its descriptive sense. As Keating acknowledges, the term “Bruxer” is used to refer to “[a] person who suffers from bruxism.” (SAA ¶ 46). In turn, “bruxism” refers to a condition of a patient who habitually grinds teeth. (*Id.*). Keating uses the term “bruxer,” however, in connection with the sale of “crown[s] made from zirconia.” (SAA ¶ 42). Thus the term “Bruxer” simply does not describe Keating’s product – Keating’s product is not a person who grinds teeth. Instead, Keating’s use of the term “Bruxer” suggests a crown that is sufficiently strong to withstand the grinding of teeth, as explained in Glidewell’s co-pending MSJ re Validity, at pages 14-19. Thus, Keating is, *in its trademark*, attempting to utilize *the exact same meaning* associated with Glidewell’s registered BruxZir mark. (*Id.*) This is the opposite of fair use. The Court should therefore reject Keating’s fair use defense.

D. The Court should Deny Keating’s Request for Summary Judgment on Glidewell’s Second and Third Causes of Action

Keating contends that the Court should grant summary judgment on Glidewell’s Second and Third Causes of Action for same reasons it advanced for summary judgment as to Glidewell’s First Cause of Action. For the same reasons set forth above, Keating fails. Thus, the Court should deny Keating’s request.

III. CONCLUSION

This Court should deny Keating’s Motion for Summary Judgment of No Infringement in its entirety.

Dated: November 26, 2012

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Glidewell Laboratories v. Keating Dental Arts, Inc.
United States District Court, Central, Case No. SACV11-01309-DOC (ANx)

CERTIFICATE OF SERVICE

I hereby certify that on November 26, 2012, I electronically filed the document described as **JAMES R. GLIDEWELL DENTAL CERAMICS, INC. MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION TO DEFENDANT KEATING DENTAL ARTS, INC.'S MOTION FOR SUMMARY JUDGMENT OF (1) NO INFRINGEMENT OF GLIDEWELL'S REGISTERED TRADEMARK, (2) NO VIOLATION OF SECTION 43(a) OF THE LANHAM ACT, AND (3) NO UNFAIR COMPETITION UNDER CALIFORNIA LAW** with the Clerk of the Court using the CM/ECF System which will send notification of such filing to the following:

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